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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,428	08/07/2001	Lei Wu	4718420005000	3614

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MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

EXAMINER

CHEU, CHANGHWA J

ART UNIT	PAPER NUMBER
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1641

DATE MAILED: 12/03/2002

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/924,428

Applicant(s)

WU ET AL.

Examiner

Jacob Cheu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-114 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-114 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-34, 56-57, 67-68 and 92-95, drawn to a microdevice, classified in class 422, subclass 119.
 - II. Claims 35-41, drawn to a method of isolating a moiety, classified in class 436, subclass 63.
 - III. Claims 42-55, drawn to a method for manipulating a moiety, classified in class 436, subclass 526.
 - VI. Claims 58-66, drawn to a method for detecting a moiety, classified in class 435, subclass 7.92.
 - V. Claims 69-91, drawn to a method of synthesizing a library, classified in class 435, subclass 975.
 - VI. Claims 96-98 and 107-114, drawn to a two-dimensional optical encoder, classified in class 436, subclass 164.
 - VII. Claims 99-103, drawn to a carrier for chemical synthesis, classified in class 422, subclass 119.
 - VIII. Claims 104-106, drawn to a carrier for labeling a substance, classified in class 436, subclass 543.
2. Inventions I, and (II-V) are related as apparatus and process for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case invention I can be used as a materially different method other than the methods claimed by inventions II-V, such as for identification of counterfeit coins with a specific fluorescence other than isolating moieties, manipulating moieties, detecting moieties or array for detecting moieties or synthesizing an entity corresponding to the photorecognizable coding pattern.

Inventions I, and VI-VIII are unrelated, distinct and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they

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have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the feature of having a binding partner that is capable of binding to a moiety to be detected on the microdevice, is not required by the claims of other inventions VI-VIII. Likewise, the feature of chemically modifying the non-encoding regions of the surface of the encoders in invention VI, is not required by the claims of inventions I, VII and VIII. The feature of the optical code identifies a chemical reaction to be conducted on the surface in invention VII, is not required by the claims of inventions I, VI and VIII. Similarly, the feature of the a carrier for labeling a substance in invention VIII, is not required by the claims of inventions I, VI and VII. Therefore, each invention has different mode of operation and functions.

Inventions II, III, IV and V are unrelated, independent and distinct inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The step of recovering said microdevice from said sample for isolating a moiety in invention II, is not required by the claims of inventions III, IV and V. The step of manipulating said-moiety-microdevice complex with a physical force in a chip format or in a non-chip format in invention III, is not required by the claims of inventions II, IV and V. The step of detecting moieties in invention IV, is not required by the claims of inventions II, III and V. The step of synthesizing an entity corresponding to the photorecognizable coding pattern on the microdevice in invention V, is not required by the claims of inventions II, III and IV. Therefore, each invention has different mode of operation and functions.

Inventions (II, III, IV and V), and (VI-VIII) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the instant case the products from inventions VI-VIII, can be practiced by another materially process other than recovering the microdevice as claimed in invention II. Similarly, the products from inventions VI-VIII, can be practiced by another materially process other than coupling moiety to

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microdevice via binding between moiety and binding partner to form a moiety-microdevice complex as claimed in invention III. Likewise, the products from inventions VI-VIII, can be practiced by another materially process other than detecting binding between moiety and the binding partner in a chip format or in a non-chip format as claimed in invention IV.

Furthermore, the products in VI-VIII, can be practiced by materially different method other than synthesizing a library with microdevice wherein at least one of said microdevices does not comprise an anodized metal surface layer as claimed in invention VII. Therefore, process inventions II-V and apparatus inventions VI-VIII are independent and distinct inventions.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search for one group is not required for the other, therefore restriction for examination purposes as indicated is proper.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Cheu whose telephone number is 703-306-4086. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3399.

Jacob Cheu

Examiner

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November 19, 2002



LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

12/62/02